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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/615,351	07/12/2000	Wlodek W. Zadrozny	728-168 (YOR9-2000-0204)	3274
7590 12/17/2004			EXAMINER	
Paul J Farrell Dilworth & Barrese 333 Earle Ovington Blvd Uniondale, NY 11553			MOONEYHAM, JANICE A	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/615,351

Applicant(s)

ZADROZNY ET AL.

Examiner

Jan Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-14,16-23,46,48-56 and 82 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-14,16-23,46,48-56 and 82 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. This is in response to the applicant's communication filed on October 14, 2004, wherein:
Claims 1-2, 4-14, 16-23, 46, 48-56 and 82 are currently pending in this application;
Claims 1-2, 14, 46, 48-55, and 82 have been amended;
Claims 3, 15, 47, and 83 have been cancelled;
No claims have been added.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 14, 2004 has been entered.

Response to Amendment

Claim Rejections - 35 USC § 101

3. Claims 1-2, 10-13, 46, 48-51 have been amended. The rejection of these claims under 35 U.S.C. 101 is *withdrawn*.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-2, 4-13, 46, and 48-56 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case claims 1-2, 4-13, 46, and 48-56 are in the technological arts.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention includes a confidentiality level associated with the subjective interpretation of a human (see page 31, the Security System represents any type of system, computer or human). Therefore, the claim language is not concrete. Applicant states that the Security System establishes a confidentiality level for each Patent Proposal record in the Patent Proposal Database Server (page 30, line 20 through page 31, line 5).

On page 11, lines 13-20, the applicant states that the first state, Idea Development involves the proposal of an idea and the initial discussions concerning it, as the proposer of the idea assess potential co-inventors and further fleshes out details. The subjective decisions of the proposer render the claim language not to be concrete.

Claim Rejections - 35 USC § 112

5. Claims 1-2, 4-14, 16-23, 46, 48-56, and 82 were rejected under the second paragraph of 35 U.S.C. 112 for not developing being directed to the claimed invention. The applicant has amended the preamble to better identify the invention. Therefore, this rejection is hereby *withdrawn*.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-2, 4-14, 16-23, 46, 48-56, and 82 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The applicant stores criteria for matching. However, it is unclear how the matching is performed. What determines the desired qualifications?

It is unclear how the confidentiality level is used to eliminate a subscriber from the pool. How does the Patent Proposal Database server understand the requirements sent by the initial inventor and choose which users to solicit with the patent idea as set forth on page 30 of the specification?

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How does the Security System establish a confidentiality level for each Patent Proposal record? How is the importance of the idea determined?

The applicant states that the security system *may* have a central processing unit which uses a heuristic analysis program to weight these factors and determine an appropriate confidentiality level (page 31 or specification). On the other hand, the Security System may analyze the data and present a report to a patent proposal committee or patent proposal manager, who determines the appropriate level of confidentiality based on their knowledge of the situation and contact with other managers in the corporation. In short, the Security System represents any type of system, computer or human, which designates a confidentiality level for a patent proposal. Who determines the threshold? It is unclear how these determinations are performed?

In claims 49-51 and 54-55, it is unclear how the fee collection system is obtained. It is unclear how obtaining a fee from at least one subscriber entitles the subscriber to subscribe to the subscriber list.

It is unclear what the Co-Inventor Solicitor comprises (page 33 of specification). The applicant states that the newly-created patent proposal database record is sent to the Co-Inventor Solicitor, which selects potential co-inventors. The Co-Inventor Solicitor generates the co-inventor pool from these two searches and appends it to the database record.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 9-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear how the non-subscribers are added to the created pool of co-inventors by searching said non-subscriber database for non-subscribers that match desired co-inventors.

8. On pages 18-19 of the specification, the applicant identifies that all employees of the corporation are listed in the non-subscriber database (18, lines 20-21). On page 19, the applicant states that employees first sign up, or subscribe, to the patent drafting program in order to indicate their willingness to be a co-inventor. This sign up procedure copies the non-subscriber record concerning the employees into the subscriber database record (page 19, lines 18-22). On page 24, lines 19-21, the specification states that once these fields are filled, the subscriber database record is complete and stored in the subscriber database. Therefore, it is unclear how adding individuals to the created pool of co-inventors is performed by searching said non-subscriber database for non-subscribers that match the desired inventor qualifications. It appears that all of the searching and matching would only be done in the subscriber database.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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9. Claims 1-2, 4-14, 16-23, 46, 48-56 and 82 are rejected under 35 U.S.C. 102(e) as being anticipated by Linz (US 2001/0032112).

Linz discloses a method and system (Fig. 1) comprising creating a list (Fig. 2 (202)), receiving information (page 2 [0022]), creating criteria or qualifications (page 2[0022] first database, searching and matching based on the criteria (page 2 [0022] Fig. 2 (200)), and contacting those matched (Fig. 2 – (206) transmit information to candidates, col. 1 [0010]).

Linz does not disclose developing an invention, a subscriber list, receiving a proposal, or creating a pool of co-inventors. The fact that the method for searching a database based on the qualifications is for developing an invention is non-functional descriptive material and is given little patentable weight. The fact that the list is a subscriber list, that the information is a proposal, and that the qualifications are for co-inventors or that the match list is identified as a co-inventor pool is also non-functional descriptive material and carries little patentable weight. They add little, if anything, to the claimed steps and thus do not serve as a limitation on the claims to distinguish over the prior art.

The dependent claims are rejected for incorporating the defects from the parent claim by their dependency

10. Claims 1-2, 4-13, 46, and 48-56 are rejected under 35 U.S.C. 102(b) as being anticipated by Atcheson et al. (US Patent 5,583,763) (hereinafter referred to Atcheson).

Atcheson discloses a method comprising creating a list (database includes a plurality of datafiles containing a plurality of preferences, Fig. 4.(300), (302)), receiving information, creating criteria or qualifications (target user inputs signal to indicate a set of preferences), and

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searching or matching based on the criteria (database is searched to determine the number of user preferences that match preferences in the datafiles) (Fig. 3, 4 col. 2, lines 16-27)

Atcheson does not disclose developing an invention, a subscriber list, receiving a proposal, or creating a pool of co-inventors. The fact that the method for searching a database based on the qualifications is for developing an invention is non-functional descriptive material and is given little patentable weight. The fact that the list is a subscriber list, that the information is a proposal, and that the qualifications are for co-inventors or that the match list is identified as a co-inventor pool is also non-functional descriptive material and carries little patentable weight. They add little, if anything, to the claimed steps and thus do not serve as a limitation on the claims to distinguish over the prior art.

The dependent claims are rejected for incorporating the defects from the parent claim by their dependency.

11. Claims 14, 16-23 and 82 are rejected under 35 U.S.C. 102(b) as being anticipated by Atcheson.

Atcheson discloses a network (100) used to transfer information, a server (inherent in a network system), a terminal for transmitting information (108), a database for storing list and records (Fig. 2, fig. 3 (210), fig. 4(300, 301).

The fact that the system is used by inventors, co-inventors, for developing an inventive idea or that the information is a patent proposal is all non-functional descriptive material and is given little patentable weight.

The dependent claims are rejected for incorporating the defects from the parent claim by their dependency.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-2, 4-13, 46, 48-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atcheson et al. (US Patent 5,583,763) (hereinafter referred to Atcheson) in view of Harshaw et al (US 6,542, 871).

Atcheson discloses a method comprising creating a list (database includes a plurality of datafiles containing a plurality of preferences, Fig. 4(300), (302)), receiving information, creating criteria or qualifications (target user inputs signal to indicate a set of preferences), and searching or matching based on the criteria (database is searched to determine the number of user preferences that match preferences in the datafiles) (Fig. 3, 4 col. 2, lines 16-27).

Atcheson does not disclose developing an invention, a subscriber list, receiving a proposal, or creating a pool of co-inventors, or contacting the subscribers in the pool.

However, Harshaw discloses developing an invention (col. 1, lines 36-40, col. 1, line 66 thru line 9), a subscriber list (Fig. 1 (Registrants), receiving a proposal (col. 1, lines 36-41, col. 1, line 66 thru col. 2, line 9, col. 2, line 47 thru col. 3, line 17), or creating a pool of co-inventors (Fig. 1, Pool, col. 2, line 47 thru col. 3, line 17), or contacting the subscribers in the pool (col. 3, lines 29-35).

It would have been obvious to one of ordinary skill in the art to incorporate into the disclosure of Atcheson the teachings of Harshaw since it is desirable to have a method for

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developing new products for introduction into the marketplace and a method for accumulating new product ideas in a pool.

The dependent claims are rejected for incorporating the defects from the parent claim by their dependency.

13. Claims 1-2, 4-14, 16-23, 46, 48-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eisenhart (US 2001/0047276) (hereinafter referred to as Eisenhart).

Referring to Claims 1, 14, 16-23, 46:

Eisenhart discloses a method and system for supporting the development of inventions by a plurality of inventors, the method comprising the steps of:

creating by a first computing device a subscriber list, said list comprising records, each of said records having at least a name, contact information and qualifications (page 1 [0013], page 2 [0014];

storing said list in a database Figs. 1-7B);

receiving by the first computing device a proposal for an invention from an inventor, said proposal including desired qualifications (page 2 [0014] need profile);

creating by the first computing device a set of desired qualifications (Fig. 3 (322) (Qualification); and

storing the set of desired qualifications in a database (Figs. 1-7b, Fig. 3 (322));

creating by the first computing device a pool by searching for records in the list with qualifications matching the desired qualifications, wherein said created pool develop the invention described in the proposal for invention (page 2 [0014]); and

contacting by the first computing device subscribers in the pool to inform them of the proposal for the invention (page 2 [90015]).

Eisenhart discloses a pool of an originator of technology (Supplier), anyone interested in funding, licensing, or purchasing the technology (Buyer) or contributing to the commercial development of the technology (Contributor). Eisenhart does not disclose that said subscriber list is a list of co-inventors, that the qualifications are co-inventor qualifications, and that the pool is co-inventors that develop the invention. However, the type of individuals is considered to be non-functional descriptive data which is not functionally related to the steps of structure of the system. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F 2d 1381, 1385, 217 USPQ 401, 404 (Fed Cir. 1983); *In re Lowry*, 32 F 3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate co-inventors into the method and system of Eisenhart since such data does not functionally related to the steps or structure and because the subjective interpretation of the data does no patentable distinguish the claimed invention.

Referring to Claim 2:

Eisenhart discloses a method further comprising the steps of providing the first computing device a form for the pool to communicate and further develop the proposal for the invention (Figs. 2-3 – collaboration manager (325), Page 1 [0010}). See Claim 1 as to non-functional language.

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Referring to Claim 4:

Eisenhart discloses a method wherein the proposal for the invention is transmitted over the network, wherein at least one of said plurality of computing devices is used by the initial inventor and at least one of said plurality of computing devices is used for receiving the proposal for invention (Figs. 1-7b, page 1 [0010])).

Referring to Claim 5:

Eisenhart discloses a method wherein the step of creating a pool is performed by a server Figs. 1-7b, page 1 [0010] thru page 2 [0014], page 5 [0061]).

Referring to Claim 6:

Eisenhart discloses a method wherein the step of contacting subscribers is performed over the network, each of said plurality of computing devices being accessible by one or more subscribers in the pool (Figs. 1-7b, page 2 [0014]- sends an alert message to the member when an interesting profile or event occurs in the system, page 3 [0038]).

Referring to Claim 7:

Eisenhart discloses a method wherein the step of providing a forum is performed over the network by a server (Figs. 1-7b, page 1 [0010], page 2 [0031]).

Referring to Claim 8:

Eisenhart discloses a method wherein the step of providing a forum further comprises a step of providing at least one web page as the forum (Figs. 1-7b. page 1 [0010]).

Referring to Claim 9:

A method wherein the step of creating a list further comprising the steps of:
contacting a database by a user;

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creating a record by the user;

inputting by the user information including a name of the user, contact information and qualification; and

storing the record in the database (page 1 [0013] thru page 4 [0014]).

Referring to Claim 10:

A method wherein the steps of creating the list comprises:

establishing criteria (page 2 [0014]- need profile;

using the criteria to select and individual (page 2 [0014];

creating records for the selected individuals, each record including information (page 5 [0057];

maintaining the records in a second database (Figs. 1-7b).

Referring to Claim 11:

A method further comprising adding individuals to the pool by searching the database that match the desired qualifications (page 2 [0014]).

Referring to Claim 12:

A method wherein each record includes a confidentiality level (page 3 0033] – confidential data, page 4 [0042]).

Referring to Claim 13:

A method wherein the step of creating a set of desired qualification further comprises the step of establishing a confidentiality level for the proposal for invention (page 2 [0014] need profile can contain any type information – need profile is tailored to the member's role and includes specific characteristics that the member is looking for).

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Referring to Claim 48:

A method further comprising the step of providing by the computing device a forum for the pool to further develop the proposal for the invention (Figs. 1-7B, page 1 [0010]).

Referring to Claims 49-51 and 54-55:

A method comprising the step of obtaining by a fee collection system a fee from at least one subscriber entitling the user to subscribe to the list, obtain information (Figs. 1-7b, Fig. 3, page 1 [0012], page 3 [0041] thru 4 [0043] Member Registration).

Referring to Claims 52 and 56:

Eisenhart discloses a method support for the development of inventions comprising providing a secured forum on a network for a pool to communicate and develop a proposal (Figs. 1-7b, page 1 [0010]).

Referring to Claim 53:

Eisenhart discloses a method further comprising providing at least one web page as means for the secured forum (Fig 3 (331) Secure Collaboration Manager, page 4 [0042]).

Referring to Claim 82;

Eisenhart discloses a computer system comprising at least one computer-readable memory (Figs. 1-7b, page 2 [0031] thru page 3 [0036]).

Response to Arguments

14. Applicant's arguments filed October 14, 2004 have been fully considered but they are not persuasive.

The applicant's argues that Atcheson does not disclose pool and contacts only one user not multiple users in the pool. It is the Examiner position that the method and system of Atcheson could function with multiple users as is evidence in column 2, lines 8-11 – the invention is applicable to any type of information “objects” that can be ordered according to the preferences of a user, or subject.

Furthermore, the Examiner has provided new grounds of rejections.

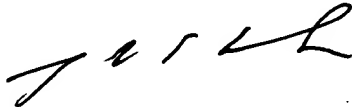
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan Mooneyham whose telephone number is (703) 305-8554. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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